

REMARKS

Responsive to the Final Office Action dated March 3, 2005, Applicants hereby make the following response. In this Amendment, Applicant has canceled Claims 8 and 9 and has amended Claims 1 and 4. Accordingly, Claims 1, 4, 14-19 and 22-26 remain pending for prosecution.

I. Specification Objections

The amendment filed 12/17/04 was objected to as introducing new matter into the disclosure. In particular, it was asserted that the compound Ni_2Si was not supported by the original disclosure. Applicant respectfully submits that the original disclosure recited the compound ". . . $\text{MgSaANi}_2\text{Si}$ " Clearly, this is not an actual compound but a typographical error brought on by the translation of the specification from Japanese to English. This compound was obviously meant to read " Mg_2Si and Ni_2Si " which is supported by the Japanese priority document. Applicant therefore respectfully submits that no new matter has been added to the specification and therefore requests withdrawal of this objection.

II. The § 112 Rejections

Claims 1, 4, 8, 9, 14-19 and 22-26 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant has amended Claims 1 and 4 to eliminate the rejected limitations. Applicant respectfully submits that Claim 22 is supported by the specification as discussed above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

III. The § 102(b) Rejection

Claims 1, 4, 8, 9, 14-19, and 23-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. 10-312789 to Inamasu. For the following reasons, Applicant

respectfully submits that the present invention is not anticipated under § 102(b) and requests reconsideration and withdrawal of this rejection.

Claims 1, 4, 8, 9, 14-19, and 23-26 are not anticipated by the cited reference because Inamasu fails to teach each and every limitation of these claims. Specifically, Inamasu fails to teach a cathode composed of $\text{Li}_x\text{M}_y\text{PO}_4$ having an olivine structure and having a particle diameter not greater than 1 micrometer and wherein $0 < x \leq 2$ and $1 \leq y \leq 2$.

Thus, because Inamasu fails to disclose every limitation of independent Claims 1 and 4, it does not anticipate these claims and the claims depending therefrom and cannot therefore cannot be used to support a rejection under § 102(b). Applicant therefore respectfully requests that this rejection be withdrawn.

IV. The § 103(a) Rejection

Claims 1, 4, 8, 9, 14-19 and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,705,296 to Kamauchi et al. in view of U.S. Patent No. 6,576,369 to Moriguchi et al. and further in view of U.S. Patent No. 5,910,382 to Goodenough et al.. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Kamauchi does not teach or suggest the claimed invention. In particular, Kamauchi fails to teach or suggest a cathode composed of $\text{Li}_x\text{M}_y\text{PO}_4$ having an olivine structure and having a particle diameter not greater than 1 micrometer and wherein $0 < x \leq 2$ and $1 \leq y \leq 2$. Similarly, both Moriguchi and Goodenough fails to teach or suggest these elements of Applicant's claimed invention. In fact, the cited references teach away from the present invention. In the cell of the present invention, the deterioration of cell capacity is prevented because the lithium ions are smoothly diffused and destruction of the olivine structural crystal is suppressed. The inventions disclosed in the cited references are not able to overcome this problem. Moreover, the particle diameter of the active materials disclosed by the cited references is so large that destruction of the active material structures cannot be suppressed.

Therefore, there is no reasonable expectation of success in achieving the invention as claimed when the cited references are modified or combined. As discussed above, none of the cited references contain all the elements of Applicants' independent claims 1 and 4. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, none of the references cited teach or describe *all* of the limitations claimed by Applicant in independent claims 1 and 4 and the claims depending therefrom. It would therefore not have been obvious to one of ordinary skill in the art to provide a cathode active material comprising an active material including $\text{Li}_x\text{M}_y\text{PO}_4$ having an olivine structure and having a particle diameter not greater than 1 micrometer and wherein $0 < x \leq 2$ and $1 \leq y \leq 2$. Accordingly, independent claims 1 and 4 and the claims depending therefrom are nonobvious under § 103 (a).

V. Conclusion

Accordingly, Applicant respectfully submits that the present application is now in condition for allowance and courteously solicits the same. If the Examiner should have any

questions regarding the foregoing, she is encouraged to call the undersigned at 816.460.2516.

Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct any such fees from Deposit Account No. 19-3140.

Respectfully submitted,

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